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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/838,368
Filing Date: April 19, 2001
Appellant(s): DUTTA ET AL.

Wayne Bailey
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 29, 2007 appealing from the Office action mailed August 11, 2006

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board' s decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant' s statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant' s statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,401,113	Lazaridis et al	6-2002
6,088,515	Muir et al	7-2000
6,356,529	Zarom	3-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 6, 7, 14-16, 25, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al (U.S. Patent No. 6,401,113) in view of Muir et al (U.S. Patent No. 6,088,515)

3. As per claim 6, Lazaridis et al teach a method for backing up data, the method comprising:

establishing at a server a connection with a wireless device over a wireless network using a wireless protocol (column 1, lines 22-25 and 30-43);

pushing, over the wireless network to the wireless device, a request to backup data (column 7, lines 31-34 and column 4, lines 45-46, column 1, lines 30-43; instead of mobile device requesting synchronization, host uses push paradigm that continuously transmits user selected items upon detection of trigger event), wherein the step of pushing the request comprises a textual based service load to a proxy, wherein the proxy is configured to translate the textual based service load to a binary service load and send the translated binary based service load to the wireless device (column 6, lines 9-17 and Figure 1, element 20; a wireless gateway that forms a bridge between the WAN and a wireless network, which inherently converts textual based loads to binary service loads in order to send data from a wireline to a wireless network);

receiving the data from the wireless device (column 7, lines 31-34 and column 4, lines 45-46); and

storing the data on, a storage device coupled to the wireless network (column 3, lines 12-13).

4. Lazaridis et al teach that a redirector program, which allows for the mirroring/synchronization of user data and can operate at the user' s mobile device (see column 4, line 46-48, column 2, line 66-column 3, line 3) but *fail to teach* a service load provides *a uniform resource identifier for an application that the wireless may retrieve to transmit the data to the server.*

5. However, Muir et al teach a client node is provided with a web page that contains a hyperlink corresponding to a configuration file located on a network server. The browser obtains the configuration file and is used by the client node to interact with an application program located on a remote server. The client agent located on the client device can then interact with the application program to perform functions such as transmit data to the remote server. The hyperlink (uniform resource identifier) associated with the configuration file is therefore used to retrieve the application (column 3, lines 1-42, abstract, Fig. 1). It would have been obvious to one of the ordinary skill in the art to combine the teachings of Lazaridis et al and Muir et al because doing so would allow for a server to provide the client an address which can be used to access an application located on a server to back up data from the client device to server. This would greatly benefit client devices with very limited resources by allowing users to backup data to a server without requiring the backup program to be stored on the user' s client device.

6. As per claim 7, Lazaridis et al teach that a redirector program, which allows for the mirroring/synchronization of user data, can operate at the user' s mobile device (see column 4, line 46-48, column 2, line 66-column 3, line 3) but fail to teach *sending a request by the*

wireless device to the proxy to retrieve the application identified by the uniform resource identifier; and receiving the application by the wireless device

7. However, Muir et al teach a client node is provided with a web page that contains a hyperlink corresponding to a configuration file located on a network server. The browser obtains the configuration file and is used by the client node to interact with an application program located on a remote server. The client agent located on the client device can then interact with the application program to perform functions such as transmit data to the remote server. The hyperlink (uniform resource identifier) associated with the configuration file is therefore is used to retrieve the application (column 3, lines 1-42, abstract, Fig. 1).

Although Muir et al teach that the application is executed on the server and not received by the wireless device, it would have been obvious to receive that application at the wireless device (as evidenced by Lazaridis et al, who teach the redirector program is executed on the wireless device), in order to use the application on the device to backup data. It would have been obvious to one of the ordinary skill in the art to combine the teachings of Lazaridis et al and Muir et al because doing so would allow for a server to provide the client with an address which can be used to access an application located on a server to back up data from the client device to server.

8. As per claim 14, Lazaridis et al teach a method for backing up data, the method comprising:

responsive to receipt of a command from a backup server via a wireless network to backup data, retrieving without user intervention, the data to be backed up from storage within a wireless client (column 7, lines 24-34) and

transmitting, without user intervention, the data to be backed up to the backed up server via the wireless network utilizing a wireless protocol (column 6, lines 4-13).

9. Lazaridis et al teach that a redirector program, which allows for the mirroring/synchronization of user data and can operate at the user' s mobile device (see column 4, line 46-48, column 2, line 66-column 3, line 3) *but fail to teach* wherein the command from the backup server comprises a *location of an application to be executed by the wireless client.* However, Muir et al teach a client node is provided with a web page that contains a hyperlink corresponding to a configuration file located on a network server. The browser obtains the configuration file and is used by the client node to interact with an application program located on a remote server. The client agent located on the client device can then interact with the application program to perform functions such as transmit data to the remote server. The hyperlink (uniform resource identifier) associated with the configuration file is therefore is used to retrieve the application (column 3, lines 1-42, abstract, Fig. 1). It would have been obvious to one of the ordinary skill in the art to combine the teachings of Lazaridis et al and Muir et al because doing so would allow for a server to provide the client an address which can be used to access an application located on a server to back up data from the client device to server. This would greatly benefit client devices with very limited resources by allowing users to backup data to a server without requiring the backup program to be stored on the user' s client device.

10. As per claim 15, Lazaridis et al teach that the data to be backed up is sent to the server by way of a proxy server and is sent using a wireless application protocol (Figure 1, column 6, lines 1-18).

11. As per claim 16, Lazaridis et al teach: transmitting a request to the backup server via the wireless network to retrieve backed up data; receiving the backed up data from the backup server via the wireless network; and storing the backed up data on the wireless client (column 4, lines 34-56, column 3, lines 3, lines 14-30, column 1, lines 44-50).

12. As per claims 25 and 36, these claims contain similar limitations as claim 14 above, therefore is rejected under the same rationale.

13. As per claim 37, Lazaridis et al teach a wireless device is a wireless phone (column 6, lines 38-44).

14. As per claim 38, Lazaridis et al teach a wireless device is a personal digital assistant (column 6, lines 38-44).

15. Claims 10, 12, 13, 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al (U.S. Patent No. 6,401,113) in view of Muir et al (U.S. Patent No. 6,088,515)

16. As per claim 10, Lazaridis et al teach a method on a proxy server for facilitating data backup, the method comprising:

receiving a request from a backup server for a wireless client to backup data to the backup server (column 7, lines 31-34, column 4, lines 45-56 and column 4, lines 46-56), wherein the request is a textual based service load providing the wireless client with a uniform resource identifier for an application which will identify, locate, and transmit the requested data to the backup server;

sending the request to the wireless client over a wireless network (column 7, lines 31-34, column 4, lines 45-56 and column 4, lines 46-56);

receiving over the wireless network the data from the wireless client (column 4, lines 46-56); and

sending the data to the backup server (column 4, lines 46-56).

Although Lazaridis et al teach a wireless gateway server that bridges between a wireline network and a wireless network and inherently converts data into suitable formats for respective networks (column 6, lines 9-17 and Figure 1, element 20), Lazaridis et al does not *explicitly* teach that *data sent from a server in a first protocol is converted into a second protocol*

compatible with a wireless device and data from a wireless device is converted from a third protocol into a fourth protocol compatible with the server.

However, Zarom teaches a translation system that includes a proxy server connected to a wireless device and a server, which converts WAP protocol instructions to HTTP and TCP/IP protocol instructions. The same process is followed in reverse when the original server converts the requested content into WAP-compatible format (Figure 1 and column 2, lines 2-20).

Furthermore, Lazaridis et al teach that a redirector program, which allows for the mirroring/synchronization of user data and additional control functions, can operate at the user' s mobile device (see column 4, line 46-48, column 2, line 66-column 3, line 3; identification and location of data to synchronize is done by the redirector program once trigger event occurs) but fail to teach providing the client *with a uniform resource identifier for an application.* However, Muir et al teach a client node is provided with a web page that contains a hyperlink corresponding to a configuration file located on a network server. The browser obtains the configuration file and is used by the client node to interact with an application program located on a remote server. The client agent located on the client device can then interact with the application program to perform functions such as transmit data to the remote server. The hyperlink (uniform resource identifier) associated with the configuration file is therefore is used to retrieve the application (column 3, lines 1-42, abstract, Fig. 1). It would have been obvious to combine the teachings of Lazaridis et al and Zarom because Zarom' s use of a proxy server that converts data from a wireless protocol into HTTP instructions and vice versa in Lazaridis et al would allow for a wireless device to communicate with a server using a proxy server that converts data from a wireless protocol into an HTTP protocol, thereby allowing the ability to back-up data on a wireless device onto storage located at a remote server. It would have also been obvious to one of the ordinary skill in the art to combine the teachings of Lazaridis et al,

Zarom, and Muir et al because doing so would allow for a server to provide the client an address which can be used to access an application located on a server to back up data from the client device to server. This would greatly benefit client devices with very limited resources by allowing users to backup data to a server without requiring the backup program to be stored on the user' s client device.

17. As per claim 12, Lazaridis et al fail to teach a third protocol is a wireless application protocol.

18. However, However, Zarom teaches the use of a WAP protocol (column 1, lines 25-35). It would have been obvious to combine the teachings of Lazaridis et al and Zarom because Zarom' s use of a proxy server that converts data from a wireless protocol into HTTP instructions and vice versa in Lazaridis et al would allow for a wireless device to communicate with a server using a proxy server that converts data from a wireless protocol into an HTTP protocol, thereby allowing the ability to back-up data on a wireless device onto storage located at a remote server.

19. As per claim 13, Lazaridis et al teach a fourth protocol is a hypertext transfer protocol (column 6, lines 1-13).

20. As per claims 23 and 32, this claim contains similar limitations as claim 10 above and is therefore rejected under the same rationale.

(10) Response to Argument

As initial matter, it is noted that claims 6, 7, 10, 2-16, 23, 25, 32, and 36-38 recite combinations which only unite old elements with no change in their respective functions and which yield predictable results.

In the Brief. the Appellant argues with substance:

Argument A: *With respect to claim 6, none of the cited references teach or suggest the claimed feature of " wherein the textual based service load provides a uniform resource identifier for an application that the wireless device may retrieve and execute on the wireless device in order to transmit the data to the server" . Muir' s configuration file is not executed but rather contains information that is read from such a file and then used to establish a communication link between the client and server.*

In response, the Examiner respectfully disagrees. It is urged that claim 6 does not recite that the wireless device *executes* the application *on the wireless device.* Also, the claim' s use of the term " may" has made optional the steps that follow (retrieving of the application). MPEP ¶ 2111.04 addresses the issue of claim terms that make steps to be performed *optional* and states that the claim scope is not limited by claim language that suggests or make optional but does not require the steps. Nevertheless, the steps that follow are taught by the applied references.

Lazaridis et al teach a method of replicating information wherein a wireless device contains a redirector program (column 4, lines 46-56; here it can be seen that the redirector program " executes" on the wireless device). The redirector program allows for selection of certain data items to be replicated (column 3, lines 14-17), packages user-selected data upon detection of event triggers (column 4, lines 5-25) and includes additional control functions for determining the type of mobile data communication device and its address, for programming a preferred list of message types that are to be redirected, and for determining whether the mobile device can receive and process certain types of message attachments, such as word processor or voice attachments (see column 3, lines 42-48).

Lazaridis et al *fail to teach* a service load provides *a uniform resource identifier for an application that the wireless may retrieve to transmit the data to the server.* However, in the same field of endeavor, Muir et al teach a client node is provided with a web page that contains a hyperlink corresponding to a configuration file located on a network server. The browser obtains the configuration file and is used by the client node to interact with an application program located on a remote server. The client agent located on the client device can then interact with the application program to perform functions such as transmit data to the remote server (column 3, lines 1-42, abstract, Fig. 1). Muir teaches that the network browser obtains a network configuration file *corresponding to the application.* Although the hyperlink provided initially by the webpage (Muir: column 3, line 13) provides the user with the configuration file and not the application directly, the configuration file contains the name and address of the application selected. The user thereby can locate the application. The hyperlink (uniform resource identifier) associated with the configuration file is used to retrieve the application and therefore meets the scope of the claimed limitations.

Argument B: *Lazaridis et al fail to teach the pushing of a request to backup data. There is no teaching of receiving a command to backup data from a backup server.*

In response, the Examiner disagrees. Lazaridis et al teach a push paradigm that continuously transmits data to the mobile data communication device in response to a trigger event detected. The wireless device can then send a confirmation signal that the data has been received. The use of a confirmation signal at the wireless device to confirm that the data has been received clearly teaches that the pushed data is a request to backup data. The host is attempting or " requesting" to synchronize data using the push paradigm. This is taught by Lazaridis et al at column 1, lines 30-43. Although this section does not teach the backing up of

data from the wireless device *to* the host, column 4, lines 46-56 teach that the mobile device can backup data located on the mobile device *to* the host system.

Argument C: *In Muir, the alleged " identifier" is for a configuration file containing information that is read, whereas the identifier is for the application itself that is retrieved and executed by the wireless device.*

Muir teaches that the network browser obtains a network configuration file *corresponding to the application.* Although the hyperlink provided initially by the webpage (Muir: column 3, line 13) provides the user with the configuration file and not the application directly, the configuration file contains the name and address of the application selected. The user thereby can locate the application. The hyperlink (uniform resource identifier) associated with the configuration file is used to retrieve the application and therefore meets the scope of the claimed limitations.

Argument D: *Muir teaches that the client-requested application executed remains on the application execution server in contrast to claim 6, which recites that the wireless device may retrieve and execute on the wireless device.*

In response, the response to Argument A discusses how the applied references teach the retrieval of the application. Regarding the execution of the application on the wireless device, it is urged that claim 6 *does not recite* that the wireless device executes the application *on the wireless device.*

Argument E: *A person skilled in the art would not have been motivated to modify such teachings.*

In response, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396) .

Furthermore, although our predecessor court was the first to articulate the motivation suggestion-teaching test, a related test---the "analogous art" test---has long been part of the primary Graham analysis, articulated by the Supreme Court. See Dann, 425 U.S. at 227-29; Graham, 383 U.S. at 35. The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on the reference as a basis for rejection. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. Id. "[I]t is necessary to consider 'the realty of the circumstances,'---in other words, common sense---in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor".

Argument F: *With respect to claim 7, Muir' s application is not executed on the wireless device but rather on a remote server.*

In response, it is urged that claim 7 *does not recite* that the wireless device executes the application *on the wireless device.* Although Muir et al teach that the application is executed on the server and not received by the wireless device, it would have

been obvious to receive that application at the wireless device (as evidenced by Lazaridis et al, who teach the redirector program is executed on the wireless device) (see column 4, lines 46-56), in order to use the application on the device to backup data.

Argument G: *Muir reference does not teach or suggest the claimed feature of " sending a request by the wireless device to the proxy server to retrieve an application identified by the uniform resource identifier, receiving the application by the wireless device and executing the application by the wireless device to transfer the data requested to be backed" .*

In response, this argument is similar to Argument A and has been addressed therein.

Argument H: *Lazaridis and Muir fail to teach that the ' application' performs the functions of identify, locate, and transmit the requested data.*

In response, the Examiner respectfully disagrees. Lazaridis et al teach a method of replicating information wherein a wireless device contains a redirector program (column 4, lines 46-56; here it can be seen that the redirector program " executes" on the wireless device). The redirector program allows for selection of certain data items to be replicated (column 3, lines 14-17), packages user-selected data upon detection of event triggers (column 4, lines 5-25), transmits data items (column 1, lines 20-22), and includes additional control functions for determining the type of mobile data communication device and its address, for programming a preferred list of message types that are to be redirected, and for determining whether the mobile device can receive and process certain types of message attachments, such as word processor or voice attachments (column 3, lines 42-48).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner' s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ramsey Refai

Conferees:

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F. RYAN ZEENDER
SUPERVISORY PATENT EXAMINER

Vincent Millin